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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/663,543

09/15/2000

Hideo Kawahara

1232-4647

3853

7590

05/05/2004

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EXAMINER

JERABEK, KELLY L

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 05/05/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,543

Applicant(s)

KAWAHARA, HIDEO

Examiner

Kelly L. Jerabek

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 8-13,20,29-31,33,35-37,39,41 and 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,14-19,21-28,32,34,38,40 and 42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

First Species: figures 1-4

Second Species: figures 5-8

Third Species: figures 9-10

Fourth Species: figures 11-13

Fifth Species: figures 14-16

Sixth Species: figures 17-18

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently there is no generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Ken Waszkiewicz on 4/20/2004 to request an oral election to the above restriction requirement, which resulted in an election being made. The applicant elected the first species corresponding to figures 1 – 4 without traverse. The applicant elected claims 1-7, 14-19, 21-28, 32, 34, 38, 40, and 42 pertaining to the first elected species. The remaining claims are withdrawn from further consideration.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 14-16, 21-25, 32, 34, and 38 rejected under 35 U.S.C. 102 (b) as being anticipated by Ohta et. al US 5,703,638.

Re claim 1, Ohta discloses in figure 7 a magnetic recording apparatus capable of recording a still image along with a moving image (col. 4, lines 1-18). The magnetic recording apparatus includes an image-sensing element (310) that converts an image of an object passed through an optical system including optical transparent members (300) to an image signal (col. 4, lines 60-67; col. 6, lines 59-67). The magnetic recording apparatus also includes an image processing device that performs moving image signal processing for processing the image as a moving image signal and still image signal processing for processing the image as a still image signal (col. 7, lines 1-12). When still image signal processing is to be executed a predetermined control is

performed or a predetermined limitation is applied in response to movement of actuators that drive the optical transparent member (col. 7, lines 13-32). The flow of operation procedures within the shutter control device (320) of fig. 7 regarding moving image signal processing is similar to the flow shown in figure 4. Therefore, when moving image signal image processing is to be executed the predetermined control is not performed (col. 5, lines 48-67; fig. 4).

Re claim 2, when the recording apparatus is in the still-image shooting mode a check is made to see if the automatic white-balance control is in a transition period (eg. The actuators are in motion). If the AWB control is judged to be in a normal state the flow of figure 8 goes straight to the shutter-driving step (702) (col. 7, lines 13-32). Therefore, the signal processing device does not perform the predetermined control or does not apply the predetermined limitation when the optical transparent member does not move to the predetermined position (eg. The actuators are not in motion).

Re claim 3, when a release button is turned on in the still image shooting mode the AWB control state is monitored and the shutter operation is inhibited if it is determined that the AWB control is in a transition period (col. 7, lines 33-46). Therefore, the signal-processing device limits the still image signal processing as the predetermined control.

Re claim 4, when a release button is turned on in the still image shooting mode the AWB control state is monitored and the shutter operation is inhibited if it is determined that the AWB control is in a transition period (col. 7, lines 33-46). Therefore, the signal-processing device inhibits the still image signal processing as the predetermined control.

Re claim 5, the still image signal processing includes a recording process of a still image signal on an image-recording medium (3155) (col. 5, lines 1-11).

Re claim 6, when a release button is turned on in the still image shooting mode the AWB control state is monitored and the shutter operation is inhibited if it is determined that the AWB control is in a transition period so that a still image can be prevented from being recorded in an inapposite state (col. 7, lines 33-46). Therefore, the signal-processing device limits the recording process of the still image signal as the predetermined control.

Re claim 7, when a release button is turned on in the still image shooting mode the AWB control state is monitored and the shutter operation is inhibited if it is determined that the AWB control is in a transition period so that a still image can be prevented from being recorded in an inapposite state (col. 7, lines 33-46). Therefore, the signal-processing device inhibits the recording process of the still image signal as the predetermined control.

Re claim 14, the magnetic recording apparatus is provided with detecting means for detecting the state of a camera control action when the apparatus is in the mode of still image recording to determine if the camera control action is in a transition period (col. 4, lines 10-17).

Re claim 15, the magnetic recording apparatus of figure 7 includes a focusing lens group (300). The focusing lens group (300) is an optical transparent member.

Re claim 16, see claim 15.

Re claim 21, see claim 1.

Re claim 22, see claim 2.

Re claim 23, according to the first embodiment disclosed by Ohta in figure 3, when the magnetic recording apparatus is in the still image shooting mode a check is made to determine if the focusing lens group (300) or the zooming lens group (302) is in motion. If either of the lens groups is in motion they are forcibly brought to a stop (col. 6, lines 3-18). Furthermore, Ohta states that it is possible to arrange a magnetic recording apparatus by combining the first embodiment (fig. 3) and the second embodiment (fig. 7) (col. 7, lines 61-63). Therefore, the signal-processing device

inhibits the optical transparent member to move to the predetermined position as stated in the first embodiment according to figure 3.

Re claim 24, see claim 15.

Re claim 25, see claim 15.

Re claim 32, see claim 1.

Re claim 34, see claim 21.

Re claim 38, the magnetic recording apparatus disclosed in figure 7 is capable of recording a moving image and a still image of an object passed through an optical transparent member (300) (col. 7, lines 1-20; figs. 4 and 8). In the still image shooting mode a check is made to find if the AWB control is in a transition period. If it is in a transition period the shutter operation is inhibited and the still image is prevented from being recorded (col. 7, lines 21-46). Therefore, the optical system is designed allowable for recording the moving image and not allowable for recording the still image upon movement of the optical transparent member to a predetermined position.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta as applied to claims 1 and 21 in view of Sano et al. US 6,348,940.

Re claims 17 and 26, Ohta discloses all of the limitations according to claims 1 and 21 above, however Ohta fails to state that the optical transparent member comprises an optical filter.

Sano discloses in figure 1 an image forming system (1) including an image reader (23) that includes a CCD (231), a CCD driver (232), and an optical system (233) (col. 5, lines 14-22). An optical filter and a filter driving circuit for driving the filter may be provided between the CCD (231) and the film (col. 5, lines 23-32). The use of optical filters that are movable via a filter drive circuit is well known and used in the art as shown by Sano. Therefore, it would have been obvious for one skilled in the art to have been motivated to include the optical filter and filter driving circuit as taught in Sano in the magnetic recording apparatus as disclosed by Ohta. Doing so would provide a means for controlling still image processing in response to the movement of an optical filter that is driven by a filter drive circuit (Sano: col. 5, lines 27-29).

Claims 18-19, and 27-28 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta as applied to claims 1 and 21 in view of Ohtake et al. US 5,875,359.

Re claims 18 and 27, Ohta discloses all of the limitations according to claims 1 and 21 above. In addition, Ohta discloses in a third embodiment a magnetic recording apparatus capable of recording in a still image or moving image mode and to allow or inhibit the execution of recording and the auto-focus action according to a focus control instruction. However, Ohta fails to distinctly state that a predetermined focal length state or focus position state is determined based on the movement of the optical transparent member to a predetermined position.

Ohtake discloses a photo-taking lens system configured with a step-zoom system (col. 2, lines 38-48). The step-zoom system includes a focusing mechanism that performs zooming based on predetermined focal length state or focus position state (col. 2, lines 30-37). Focusing lens systems including predetermined focal length and focus position states are well known and used in the art as shown by Ohtake. Therefore, it would have been obvious for one skilled in the art to have been motivated to include the focusing lens system including predetermined focal length or focus position states as taught in Ohtake in the magnetic recording apparatus including a focus control as disclosed by Ohta. Doing so would provide a means for obtaining a predetermined focal length state for the focus control based on the movement of the optical transparent member (Ohtake: col. 2, lines 32-37).

Re claims 19 and 28, see claims 18 and 27.

Claims 40 and 42 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta.

Re claim 40, see claim 1. This claim includes all of the limitations of claim 1 but states that a computer program is applied for the image sensing apparatus including program codes. Ohta is a microprocessor-based system (col. 5, lines 23-38), therefore it would have been obvious to include a computer program including program codes for carrying out this operation.

Re claim 42, see claim 21. This claim includes all of the limitations of claim 21 but states that a computer program is applied for the image sensing apparatus including program codes. Ohta is a microprocessor-based system (col. 5, lines 23-38), therefore it would have been obvious to include a computer program including program codes for carrying out this operation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ohta et al. (US 6,493,027) discloses an apparatus for still and moving image recording and control thereof. The information disclosed in this document regarding still and moving image recording control is pertinent material.

Ohta et al. (US 2001/0040626) discloses an apparatus for still and moving image recording and control thereof. The information disclosed in this document regarding still and moving image recording control is pertinent material.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kelly Jerabek whose telephone number is (703) 305-8659. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached at (703)-305-4929.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

The fax number for submitting all Official communications is (703) 872-9306.

The fax number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the Examiner at (703) 746-3059.

KLJ


VU LE
PRIMARY EXAMINER